

REMARKS/ARGUMENTS

Status of the Claims

Before this Amendment, claims 1 – 7 and 23 – 35 were present for examination. No claims are amended and no claims are added. Previously withdrawn claims 12 – 22 are canceled in the interest of placing the application in a condition for allowance. Therefore, claims 1 – 7 and 23 – 35 remain present for examination, and claims 1 and 30 are independent claims. Applicant respectfully requests reconsideration of this application.

35 U.S.C. §103(a) Rejections

The Office Action rejected claims 1 – 7 and 23 – 35 under 35 U.S.C. §103(a) as being unpatentable over the cited portions of Carlisle et al., U.S. Patent No. 5,649,118 (“Carlisle”), in view of the cited portions of Kawan, U.S. Patent No. 5,796,832 (“Kawan”). It appears that the Office Action has withdrawn its rejections based on all previously cited art, as all the current rejections are based on newly cited art. In rejecting the claims, the Office Action merely referred to Carlisle, quoting the first paragraph of the detailed description in its entirety with no specific reference. In fact, no specific teachings or suggestions were recited by the Office Action, which simply asserted that Carlisle “shows all the limitations of the claims except for specifying a remote host.” Office Action, p. 2. As a result, the Applicant is forced to guess at which portion of the references the Examiner believed applied to the elements of the claims. Consequently, the Applicant must respectfully traverse the rejection of the claims as failing to establish a *prima facie* case of obviousness.

The Federal Circuit has noted that an examiner must make out a *prima facie* case in order to establish obviousness. For example, the Federal Circuit has stated:

“The examiner cannot sit mum, leaving the applicant to shoot arrows in the dark hoping to somehow hit a secret objection harbored by the examiner. The “*prima facie*” case notion, the exact origin of which appears obscure . . . , seemingly was intended to leave no doubt among examiners that they must state clearly and specifically any objections (the *prima facie* case) to patentability, and give the applicant fair opportunity to meet those objections with evidence and argument.

To that extent the concept serves to level the playing field and reduces the likelihood of administrative arbitrariness.” See In re Oetiker, 24 USPQ 2d 1443, 1447 (Fed. Cir. 1992) (Plager, J., *concurring*).

Similarly, in the context of an appeal to the board, the Board of Patent Appeals and Interferences stated:

“In the present instance, in both the final rejection (Paper No. 7, page 3) and the answer (Paper No. 10, page 4), the examiner, in rejecting claims 4, 10 and 12 under 35 U.S.C. § 102(b), has merely stated that the claims are rejected “as being clearly anticipated by . . . Moran” without any further elaboration in either office action of precisely how Moran meets the specific limitations of the rejected claims. In particular, the examiner has not addressed appellant’s argument on page 8 of the brief that the structure of Moran (1) is not a storm shelter for placement in the ground, and (2) is missing the elements of a hollow chamber because Moran includes a breaker bar extending diametrically through the bin. In addition, the examiner has not explained, and it is not clear to us, how Moran satisfies the requirement of claim 12 that the upright hollow member ‘ha[s] a height and diameter sufficient to permit at least one person to seek shelter therein,’ notwithstanding that Moran’s specification is silent as to the dimensions of the bin disclosed therein. Under these circumstances, we hold that the examiner has failed to meet the examiner’s initial burden of establishing a *prima facie* case of anticipation, such that the standing rejection of claims 4, 10 and 12 as being anticipated by Moran cannot be sustained.” Ex Parte Michael C. Martin, Appeal No. 2000-1630 (B.P.A.I. July 18, 2002) (reversing the examiner’s rejection)(Unpublished).

In view of these and other cases, it is clear that the Office must give an Applicant more guidance as to what specific portions of a reference are being relied upon in rejecting the claims. The present Office Action does not do so. Thus, the rejection of claims 1 – 7 and 23 – 35 under 35 U.S.C. §103(a) is respectfully traversed as failing to establish a *prima facie* case of obviousness and withdrawal of the rejection is respectfully requested.

Moreover, Applicant respectfully maintains that the deficiencies of the previously cited art remain in the newly cited art. Specifically, Applicant submits that the newly cited prior art still fails to teach or suggest linking a single identifier of a payment instrument to multiple accounts at a remote host, and using that remote host to generate account information based on the instrument identifier for use in point-of-sale transactions with the instrument, as recited in independent claims 1 and 30. To establish a *prima facie* case of obviousness, the cited

references, combined with the knowledge of those of ordinary skill in the art, must teach or suggest all the claim limitations. Applicant further traverses these rejections at least because the combination of Carlisle, Kawan, and ordinary knowledge in the art fails to teach or suggest all the recitations of the independent claims.

First Missing Recitation: Instrument Identifier

Claim 1 recites “receiving, at the point-of-sale device from an instrument, an instrument identifier identifying the instrument, wherein the instrument identifier is associated with a stored-value account and a credit account...; transmitting, from the point-of-sale device to the remote host, the instrument identifier.” Claim 30 contains a similar recitation. The Office Action provides no clarity as to where this recitation can be found in the art, and it appears only to refer to Carlisle as generally suggesting this recitation. Office Action, p. 2. While Carlisle discusses smart cards and a number of identifier types, none of those identifiers appears to be, or even appears to be useful as, an instrument identifier identifying the instrument.

Carlisle generally discusses technology to allow a consumer to make purchases using a number of different accounts stored on a single smart card. Notably, the multiple accounts stored on the smart card are each seemingly identified using “an account identifier for uniquely specifying a given account...” Carlisle, Col. 2, ln. 25. *Using multiple account identifiers for identifying accounts on a card is different from using a single instrument identifier to identify the instrument, and then transmitting the instrument identifier to a host to obtain associated account information.*

For example, say that stored in the memory of a smart card in Carlisle are two account identifiers associated with two accounts. To associate a third account with the card, it may be necessary to write new information to the memory of the card. This may require that memory is available, that the card recognizes the new account type, that the system adding the account is given access to the memory of the card, etc. This is different from being able to simply update a remote host to associate a new account with an existing instrument identifier, without physically impacting the customer’s payment instrument.

For at least these reasons, Carlisle fails to teach or suggest this recitation of claims 1 and 30. Further, the Office Action fails to provide any teachings from other references or any reason why this recitation would be within the knowledge of a person of ordinary skill in the art. As such, the combined teachings of the art, as cited by the Office Action, fail to teach or suggest this first missing recitation of claim 1.

Second Missing Recitation: Host Generation of Account Information

Further, claim 1 recites “receiving, at the point-of-sale device from the remote host, account information relating to the stored-value account and the credit account linked to the instrument identifier, the account information being generated by the remote host based on the instrument identifier.” Claim 30 contains a similar recitation. Again, the Office Action provides no clarity as to where this recitation can be found in the art, and it appears only to refer to Carlisle in view of Kawan as generally suggesting this recitation. Office Action, pp. 2 – 3.

It would make little sense to read Carlisle as teaching or suggesting this recitation for at least two reasons. First, as discussed above, Carlisle does not appear to disclose an instrument identifier at all, let alone one where “account information [is] generated by the remote host based on the instrument identifier.” Second, as the Office Action correctly points out, Carlisle does not “specify[] a remote host.” Office Action, p. 2.

The Office Action attempts to remedy this deficiency in Carlisle by generally citing Kawan as teaching “where the smart card and a remote host work in concert together....” Id. at 3. Again, the Office Action cites no specific teaching or suggestion of Kawan to this effect, and the Applicant is forced to generally traverse the statement. But even if, *arguendo*, Kawan teaches a remote host, there appears to be no teaching or suggestion of a remote host that generates account information based on the instrument identifier, as recited in claims 1 and 30.

For at least these reasons, it would make no sense to rely on the cited art to teach or suggest this recitations of claims 1 and 30. Further, the Office Action fails to provide any teachings from other references or any reason why this recitation would be within the knowledge of a person of ordinary skill in the art. As such, the combined teachings of the art, as cited by the Office Action, fail to teach or suggest this second missing recitation of claims 1 and 30.

Third Missing Recitation: Account Linking at a Remote Host

Even further, claim 1 recites “wherein the stored-value account and the credit account were linked to the instrument identifier at a remote host” Claim 30 contains a similar recitation. Again, the Office Action provides no clarity as to where this recitation can be found in the art, simply relying on general asserted teachings of accounts and identifiers in Carlisle and of remote hosts in Kawan.

As discussed above, it would make little sense to read Carlisle as teaching or suggesting this recitation for at least the reasons that Carlisle does not appear to disclose an instrument identifier, and Carlisle does not disclose a remote host. Also, as discussed above, a general disclosure in Kawan of a remote host is not enough to provide a teaching or suggestion of the remote host recited in claims 1 and 30. Particularly, the Office Action cites no specific reference in any art as teaching or suggesting “wherein the stored-value account and the credit account were linked to the instrument identifier at a remote host,” as generally recited in the independent claims. As such, the combined teachings of the art, as cited by the Office Action, fail to teach or suggest this third missing recitation of claims 1 and 30.

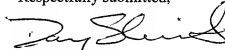
For at least the above reasons, the cited references fail to teach or suggest all the recitations of claims 1 and 30. Further, the Office Action has provided no reason why, in the absence of these teachings, the recitations of claims 1 and 30 would be known to one of ordinary skill in the art. As such, the Office Action has failed to meet its *prima facie* burden of proving obviousness. Therefore, Applicant respectfully submits that independent claims 1 and 30 are allowable. Moreover, Applicant respectfully submits that claims 2 – 7, 23 – 29, and 31 – 35 each depend from an allowable base claim, and are believed allowable for at least the same reasons as given above. Applicant, therefore, respectfully requests that the §103(a) rejections to claims 1 – 7 and 23 – 35 be withdrawn.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,



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